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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,505	11/02/2000	William C. Hein III	60288	8087
23735	7590	01/27/2005	EXAMINER	
DIGIMARC CORPORATION			COLIN, CARL G	
9405 SW GEMINI DRIVE			ART UNIT	
BEAVERTON, OR 97008			PAPER NUMBER	
			2136	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/706,505	Applicant(s) HEIN ET AL.	
	Examiner Carl Colin	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>see att</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 8/23/2004, applicant amends claim 16 to better comply with indentation requirement. The following claims 1-17 are presented for examination.

2. The amendments to the specification and claims, filed on 8/23/2004 have been considered. The objection to claim 16 and the specification has been withdrawn with respect to the amendment. The 101 rejection with respect to claims 1 and 12 has been withdrawn, but Applicant is suggested to further clarify the claimed limitations of the claimed invention.

2.1 Applicant's remarks, pages 8-11, filed on 8/23/2004, with respect to the rejection of claims 1-17 have been fully considered, but they are not persuasive. Applicant argues that the claimed "embedder instructions" are missing in Shinoda. Examiner respectfully disagrees because the "information on the web page to which a mark is attached" meets the recitation of embedder instructions (column 3, lines 19-35). Applicant also argues that Shinoda does not teach a registration process (see column 2, lines 7-17 and abstract). With respect to the step of providing authentication information to a web server, Shinoda discloses authenticating a user and discloses the limitations of claim 17 as discussed below. Applicant has not overcome the rejection. Examiner maintains the rejection of claims 1-17 using the same cited references from the previous Office Action with further clarification as discussed below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.1 **Claims 1-5, 11-17** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,611,830 to **Shinoda et al.**

3.2 **As per claims 1 and 11, Shinoda et al.** discloses a method of performing identifier registration comprising: establishing a connection with a server that performs registration process that meets the recitation of establishing a connection with a registration process, for example (see column 1, lines 8-20 and abstract); **Shinoda et al.** discloses the server authenticating the user that meets the recitation of providing authentication information to the

Art Unit: 2136

registration process (column 5, lines 10-15); submitting a registration request to the registration process (see column 4, lines 29-55); and discloses receiving content of mark management DB as file transfer (column 8, lines 1-17) that includes at least mark identifier, “information on the web page to which a mark is attached” etc. meets the recitation of embedder instructions (column 3, lines 19-35; column 4, lines 46-63) that meets the recitation of an embedder control file , including media signal identifiers and embedder instructions, for example (see column 5, lines 6-35).

As per claim 2, Shinoda et al. discloses sending request that includes identifier and instruction and embedding signal files with corresponding identifiers upon request that meets the recitation of: submitting the embedder control file to a watermark embedder, which automatically embeds a set of images, multimedia data and web pages that meet the recitation of media signal files with corresponding identifiers according to the embedder instructions in the embedder control file, for example (see column 4, lines 29-55; column 3, lines 25-50).

As per claims 3-5, Shinoda et al. discloses the claimed method of claim 1 wherein the registration process is executed at an Internet server accessible via a web interface, via an Internet communication protocol, wherein the embedder control file is received from the registration process via an Internet communication protocol for example (see abstract and column 8, lines 1-17).

As per claims 12 and 15, claim 12 discloses similar limitation as claim 1 except for allocating a set of identifiers to media signal files based on the registration process. **Shinoda et al.** discloses each record comprises of identifier for each mark image stored that meets the recitation of allocating a set of identifiers to media signal files based on the registration process, for example (see column 4, lines 29-55; column 3, lines 25-50). **Shinoda et al.** further discloses establishing a connection with a client process, for example (see column 1, lines 8-20 and abstract); and sending the embedder control file to the client process, for example (see column 5, lines 6-35; column 8, lines 1-17). Claim 15 is similar to claim 12. Claims 12 and 15 are rejected on the same rationale as the rejection of claim 1.

As per claim 13, **Shinoda et al.** discloses the claimed method of claim 12 including: creating database records corresponding to the set of identifiers and including in the database records media signal information associated with media signal files into which the identifiers are to be embedded, for example (see column 4, lines 47-55).

As per claim 14, **Shinoda et al.** discloses the claimed method of claim 13 wherein the media signal information includes a network address of a network resource associated with a corresponding media signal, for example (see column 8, lines 36-63).

As per claim 16, claim 16 recites the similar limitation as claim 2. **Shinoda et al.** discloses sending request that includes identifier and instruction and embedding signal files with corresponding identifiers upon request that meets the recitation of: submitting the embedder

Art Unit: 2136

control file to a watermark embedder, which automatically embeds a set of media signal files with corresponding identifiers according to the embedder instructions in the embedder control file, for example (see column 3, lines 25-50; column 4, lines 29-55; and column 5, lines 6-35 and column 7, line 63 through column 8, line 17) and discloses receiving content of mark management DB as file transfer (column 8, lines 1-17) that includes at least mark identifier, “information on the web page to which a mark is attached” etc. meets the recitation of embedder instructions (column 3, lines 19-35; column 4, lines 46-63) that meets the recitation of an embedder control file, including media signal identifiers and embedder instructions, for example (see column 5, lines 6-35) and corresponding media signal files (column 8, lines 35-63)

As per claim 17, Shinoda et al. discloses a media signal identifier registration server comprising: a network interface for receiving ID registration requests, the requests including a list of media signal files and information to be linked with the media signal files via data embedded in the media signal files, for example (see column 4, lines 17-47); discloses a mark creating program for creating records in a region database corresponding to identifiers for image, multimedia data and web pages that meet the recitation of media signal files with corresponding identifiers that meets recitation of a batch registration loader for creating records in a registration database corresponding to identifiers for each of the media signal files, for example (see column 4, lines 29-55; column 3, lines 25-50); also discloses a mark acquiring program and control program that meet the recitation of and a batch registration extractor for reading the registration database and creating an embedder control file, including identifiers, a corresponding list of media signal files, and embedding instructions for controlling embedding of the identifiers in the

Art Unit: 2136

media signal files, , for example (see column 3, lines 35-50) for example (see column 4, lines 1-15; 47-67 and column 7, lines 30-35).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 6-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,611,830 to **Shinoda et al.** in view of US Patent 6,679,420 to **Lapstun et al.**

4.2 **As per claims 6 and 7, Shinoda et al.** substantially discloses the claimed method of claim 1. **Shinoda et al** suggests implementing the invention in other applications but not limited to those in column 8, lines 35-65 and column 3, lines 1-6. For instance, **Shinoda et al** suggests extracting information with embedded mark to be provided to the user “the mark can be logo of a credit card company”, identifier of copyright owner, or the like. **Shinoda et al** does not explicitly disclose using a physical object or a card for extracting information and providing

Art Unit: 2136

authentication. However, **Lapstun et al.** in an analogous art teaches various applications for using embedding watermark including retrieval of coded data indicative of an identity of a user contained in a card in order to provide unique information about the owner of the card to the computer. **Lapstun et al** discloses providing authentication information by extracting information from a watermark embedded in an identity card and providing the extracted information to the registration process, for example (see column 5, lines 5-37). **Lapstun et al** discloses the limitation of using a pen for authentication to access a registration process that meets the recitation of wherein a client establishes a connection with a registration process by extracting information from a watermark on a physical object and using that information to establish the connection (column 10, lines 1-18). Therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the teaching of **Shinoda et al** for retrieving and embedding ID information to implement the inventive concept of providing authentication information by extracting information from a watermark embedded in an identity card and providing the extracted information to the registration process as taught by **Lapstun et al.** This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Lapstun et al** because it will give to the user a way to deliver authentic information through the Internet as suggested by **Lapstun et al** (column 1, lines 60-65).

As per claims 8 and 10, **Shinoda et al.** substantially discloses a request that includes a reference to look up a network address of the registration process in a database management system and discloses a request that includes a network address of the registration process, for

Art Unit: 2136

example (see column 4, lines 56-63 and column 5, lines 49-60 and column 8, lines 23-35).

Shinoda et al discloses authenticating the user as cited in claim 1. **Shinoda et al** does not explicitly disclose using a physical object as cited in claim 7. However, **Lapstun et al.** in an analogous art teaches various ways of authentication such as biometric data, credit card, and also discloses identification means using a business card to convey data from the card to a computer, the card contains coded data associated with an electronic mail address. **Lapstun et al.** also discloses a reference and network address on the physical object (see Lapstun et al. column 3, lines 54-60). Therefore claims 8-10 are rejected on the same rationale as the rejection of claims 6-7.

As per claim 9, Shinoda et al. discloses the claimed method of claim 8 wherein the database management system forwards information to the registration process to authenticate a user, for example (see column 5, lines 3-12).

Conclusion

5. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 8/26/2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2136

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

January 23, 2005


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100